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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			EXAMINER HUTTON JR, WILLIAM D	
			ART UNIT 2176	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/928,599

Applicant(s)

KOWALSKI, LEE ANNE

Examiner

Doug Hutton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-23,26-45 and 48-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-23,26-45 and 48-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Final Rejection Withdrawn

Applicant petitioned the Commissioner to withdraw the Final Rejection dated 10/05/2006 (see Petition dated 10/25/2006). The Petition to withdrawn the Final Rejection was granted (see Petition Decision dated 01/30/2007). This grant is based upon the ruling that the examiner's determination that the declaration submitted by Applicant's attorney is not eligible for consideration was improper (see Petition Decision – Page 3, fifth full paragraph).

Accordingly, Applicant's request for reconsideration of the finality of the rejection of the last Office Action is persuasive and, therefore, the finality of that action is withdrawn.

131 Declarations

The 131 declarations filed under 37 CFR 1.131 in the present application have been considered but are ineffective to overcome the Padwick and Rand references, as indicated in the following discussion.

Applicant has submitted three 131 declarations that have been considered by the examiner:

- 1) Lee Anne Kowalski, the sole inventor of the present application, signed a 131 declaration (hereinafter, the "Kowalski Declaration") submitted on 02/27/2006. The Kowalski Declaration indicates that the invention was conceived (see

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Statement 2a) before June 21, 2000 and reduced to practice on a continuous basis from that time to the filing of the present application (see Statement 3).

Thus, the Kowalski Declaration attempts to establish **conception** of the invention prior to the effective date of the references coupled with **due diligence** from prior to the reference dates to the filing date of the application (constructive reduction to practice).

- 2) Jeanette Berry Souza, the Administrative Manager in the Intellectual Property Law Department of I.B.M. Corporation's Silicon Valley Laboratory, signed a 131 declaration (hereinafter, the "Souza Declaration") submitted on 07/19/2006. The Souza Declaration indicates that the "Disclosure" document attached to the declaration existed on May 30, 2000 (see Statement 2a), and, that same day, a decision regarding whether to file the "Disclosure" document as a patent application was entered (see Statement 2a). The Souza Declaration also states that, between 06/20/2000 and 05/18/2001 (312 days), the Intellectual Property Law Department of I.B.M. Corporation's Silicon Valley Laboratory had a "normal backlog of unrelated cases," which were "taken up in chronological order" and carried out "expeditiously," and worked "reasonably hard" on the application during the 312-day period of time (see Statement 3).
- 3) George H. Gates, a registered patent attorney who is prosecuting the present application, signed a 131 declaration (hereinafter, the "Gates Declaration") submitted on 02/27/2006. The Gates Declaration states that a "Disclosure" document and instructions to draft and file a patent application was received on

May 18, 2001 (see Statement 3). The Gates Declaration further indicates that the patent application was initially drafted on May 29, 2001 and continuously updated until its filing on August 31, 2001 (see Statement 4). The examiner assumes that the Gates Declaration is submitted to further demonstrate **due diligence** from prior to the reference dates to the filing date of the application (constructive reduction to practice).

The Kowalski Declaration, the Souza Declaration and the Gates Declaration attempt to establish **conception** of the invention prior to the effective dates of the references coupled with **due diligence** from prior to the reference dates to the filing date of the application (constructive reduction to practice).

Firstly, the Kowalski Declaration, the Souza Declaration and the Gates Declaration **fail to establish conception**. Stated differently, the declarations fail to demonstrate that the claimed invention actually existed and that Applicant had possession of the claimed invention, because the Kowalski Declaration, the Souza Declaration and the Gates Declaration fail to point out where each limitation of the recited claims is proven to exist in the exhibits. In other words, the declarations fail to **map each of the recited claim limitations to those portions of the exhibits that demonstrate the invention existed**.

The declarations and exhibits must clearly explain which facts or data Applicant is relying on to show conception of the invention prior to the effective dates of the

references. Each exhibit relied upon should be **specifically referred to in the declaration, in terms of what it is relied upon to show**. Vague and general statements in broad terms about what the exhibits describe (see Statement 2b in the Kowalski Declaration) along with a general assertion that the exhibits describe a conception of the invention “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974).

Accordingly, the declarations fail to demonstrate **conception** of the invention prior to the effective dates of the references.

Applicant argues that conception of the invention is demonstrated in the “Disclosure” document, which is located in the Souza Declaration dated 07/19/2006 at Pages 3-18. In the argument, Applicant simply recites Claim 1 and states that support for Claim 1 is found within several cited passages and two cited figures of the “Disclosure” document. See *Response* dated 07/19/2006 – Page 12, first full paragraph through Page 16, second full paragraph.

The examiner disagrees.

Applicant’s argument fails to **map each of the recited claim limitations to those portions of the exhibits that demonstrate the invention existed**. That is, Applicant’s argument amounts to a “mere pleading” that the exhibits describe conception of the invention recited in Claim 1. In order to properly demonstrate

conception of the invention, each exhibit relied upon should be **specifically referred to in terms of what it is relied upon to show.**

Additionally, Applicant's argument fails to demonstrate that the invention of Claims 4-23, 26-45 and 48-66 existed prior to the effective dates of the references. The examiner notes that the recited limitations of Claims 4-23, 26-45 and 48-66 are not mentioned in Applicant's argument.

Secondly, the evidence submitted in the Kowalski Declaration, the Souza Declaration and the Gates Declaration is **insufficient to establish *due diligence*** from a date prior to the date of reduction to practice of the Padwick and Rand references to a constructive reduction to practice.

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). As indicated in the above discussion, the Souza Declaration states that, on May 30, 2000, the "Patent Evaluation team" decided the "Disclosure" document was rated "suitable" for a search (see Statement 2b). The Souza Declaration also states that, on the same day, a search for the invention described in the "Disclosure" document was requested (see Statement 2c). The Souza Declaration further states that, on June 20, 2000, the results of the search were received (see Statement 2d). Finally, the Souza Declaration states that, on May 8, 2001, the decision to proceed with the filing of the patent application was made (see Statement 2e).

On August 13, 2001, the present application was filed. Thus, from May 30, 2000 until May 8, 2001 (342 days), Applicant:

- 1) performed a search for the invention described in the "Disclosure" document; and
- 2) decided to file a patent application.

In the examiner's opinion, this is insufficient proof of due diligence. Accordingly, the declarations fail to demonstrate **due diligence** from a date prior to the date of reduction to practice of the Padwick and Rand references to a constructive reduction to practice.

Applicant argues that reasonable diligence is all that is required of an attorney and reasonable diligence is shown if the attorney worked reasonably hard on the application during the continuous critical period. Applicant also argues that, if the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, then that is sufficient to show reasonable diligence. Finally, Applicant argues that the Souza Declaration shows reasonable diligence by describing the continuous efforts involved in the constructive reduction to practice of the present application. See *Response* dated 07/19/2006 – Page 11, second and third paragraphs.

The examiner disagrees.

Applicant obtained this verbiage from *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986), and copied it directly into the Souza Declaration to "prove" due diligence. See the Souza Declaration – Statement 3. This verbiage in the

Souza Declaration is not supported by any evidence and amounts to a mere pleading. Applicant submits no evidence to demonstrate that the attorney had a "reasonable backlog" of cases which the attorney carried out "expeditiously."

Moreover, the facts in *Bey v. Kollonitsch*, are significantly different from the known facts of the present application. In *Bey*, the "continuous critical period" was 41 days, whereas the "continuous critical period" in the present application is from 06/20/2000 (the effective filing date of Rand) to 08/13/2001 (the filing data of the present application), which is a total of 419 days. In *Bey*, a single attorney was involved in the filing of 22 related patent applications, whereas the IP Department of IBM is involved in the present application, which has no related applications.

Additionally, in *Bey*, the court noted that, when considering the issue of whether an attorney has worked on cases in chronological order, the attorney has the burden of keeping good records of the dates when cases are docketed as well as the dates when specific work is done on the applications (see Page 970). In the present application, Applicant has not submitted any evidence to demonstrate that cases were worked "in chronological order."

Accordingly, Applicant's arguments and the declarations fail to demonstrate **due diligence** from a date prior to the date of reduction to practice of the Padwick and Rand references to a constructive reduction to practice.

Thus, the Kowalski Declaration and the Souza Declaration fail to establish invention of the subject matter of the rejected claims prior to the effective dates of the references on which the rejections are based

Claim Objections

Claims 4-7, 26-29 and 48-51 remain objected to because of the following informalities:

- In Claim 4, the phrase “*profile **when** the electronic message is altered when received*” in Line 2 should be amended to — profile₁ ~~when~~ wherein the electronic message is altered when received — so that it clearly indicates when the electronic message is altered. Claims 26 and 48 have the same problem.
- In Claim 5, the phrase “*profile **when** the electronic message is altered when authored*” in Line 2 should be amended to — profile₁ ~~when~~ wherein the electronic message is altered when authored — so that it clearly indicates when the electronic message is altered. Claims 27 and 49 have the same problem.
- In Claim 6, the phrase “*profile **when** the electronic message is altered when received*” in Lines 2-3 should be amended to — profile₁ ~~when~~ wherein the electronic message is altered when received — so that it clearly indicates when the electronic message is altered. Claims 28 and 50 have the same problem.
- In Claim 7, the phrase “*profile **when** the electronic message is altered when authored*” in Lines 2-3 should be amended to — profile₁ ~~when~~ wherein the

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electronic message is altered when authored — so that it clearly indicates when the electronic message is altered. Claims 29 and 51 have the same problem.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-16, 19-23, 26-38, 41-45, 48-60 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, Gordon, **Special Edition Using Microsoft Outlook 2002** (Que Publishing, 1 May 2001), in view of Rand et al., U.S. Patent Application Publication No. US 2004/0080528 A1, and further in view of Chen et al., U.S. Patent No. 6,009,442.

Claim 1:

Padwick discloses *a computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Chapter 28 – Creating and Using Rules, “*Using the Rules Wizard to Manage Incoming Messages*” Pages 1-16 of 16 → Padwick discloses this limitation in that Outlook includes an “Rules

Wizard” tool that allows the user to search emails for a particular term or phrase),
comprising the steps of:

- *creating and reading electronic messages in an electronic messaging application performed by a computer (Padwick discloses this limitation in that Outlook allows the user to create and read emails), wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network (Padwick discloses this limitation in that Outlook sends emails created by the user to a recipient via a computer network), and the electronic messaging application identifies certain words that are contained within the electronic message (as explained in the immediately following discussion, Padwick discloses this limitation) by performing the steps of:*
 - *comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry (see Figure 28.7; see Pages 1-11 of 16 → Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to create rules to filter emails based on whether user-specified terms are in the emails. Every rule created is stored on the computer, so that the rules may be subsequently applied to emails. Thus, the user-specified terms are “stored” by an “online registry.”); and*
 - *identifying the matched message terms and indicating their significance to a reader by sending electronic messages that include any matched*

significant message terms to a folder (see Figure 28.8; see Pages 1-11 of 16 → Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to specify that emails satisfying a rule are moved to a particular folder. By moving emails that include user-specified terms to a particular folder, Padwick “identifies the matched message terms” and “indicates their significance to a reader.”).

Padwick fails to expressly disclose:

- *the electronic messaging application **distinguishing** certain words that are contained within the electronic message by performing the step of:*
 - ***making alterations** to the electronic message to identify the matched message terms and to indicate their significance to a reader*
- (EXAMINER’S INTERPRETATION – These two phrases (i.e., “an application that distinguishes certain words” and “making alterations to the electronic message” essentially recite the same subject matter. That is, these limitations recite: an “electronic messaging application” that automatically “distinguishes” certain words in a “message” by “making alterations” to those words for the purpose of indicating the significance of those words to a reader of the “message.”).

Rand teaches a computer-implemented method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs

0015 and 0049 → Rand teaches this limitation in that the electronic document display system includes an “Keyword Search” tool that allows the user to search documents for a particular term or phrase), *comprising the steps of:*

- *an electronic messaging application distinguishing certain words that are contained within the electronic message (as explained in the immediately following discussion, Rand teaches this limitation) by performing the steps of:*
 - *comparing message terms in an electronic message to significant terms to identify any of the message terms in the electronic message that match the significant terms (see Figure 3; see Paragraph 0049 → Rand teaches this limitation in that the electronic document display system includes a “search” function, which generates a list of documents that include user-specified search terms); and*
 - *making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader (see Paragraph 0049 → Rand teaches this limitation in that the electronic document display system allows the user to click on any of the documents in the list and, upon selection of a listed document by the user, displays the document with the highlighted search term. By highlighting the search terms, Rand “identifies” the matched message terms by “making alterations in the electronic message itself,” which “indicates their significance to a reader.”),*

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for the purpose of calling the user's attention to the search terms and clearly indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *the electronic messaging application **distinguishing** certain words that are contained within the electronic message by performing the step of:*
 - *making alterations within the electronic message itself to identify the matched message terms and to indicate their significance to a reader,*

for the purpose of calling the user's attention to the search terms and clearly indicating the location of the search terms in the document to the user, as taught in Rand.

Padwick, in view of Rand, fails to expressly disclose/teach:

- *alterations that are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the

document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *alterations that are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches "*alterations that are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.*");

for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of:

- *alterations that are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient,*

for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

Claim 4:

Padwick discloses *significant terms that are determined based upon a reader profile* (see Chapter 28 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “*reader*”; these rules comprise the “*reader profile*” that determines the “*significant terms*”).

Padwick, in view of Rand, fails to expressly disclose/teach *an electronic message that is altered when received*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *altering the electronic message when received* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*altering the electronic message when received.*”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of *altering the electronic message when received*, for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

Claim 5:

Padwick discloses *significant terms that are determined based upon a author profile* (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that

allows the user to create rules for processing outgoing emails for the “author”; these rules comprise the “*author profile*” that determines the “*significant terms*”).

Padwick, in view of Rand, fails to expressly disclose/teach *an electronic message that is altered when authored*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *altering the electronic message when authored* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*altering the electronic message when authored*.”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of *altering the electronic message when authored*, for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

Claim 6:

Padwick, in view of Rand, fails to expressly disclose/teach:

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen

teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches *"matched message terms that are identified based upon a reader profile"* and *"altering the electronic message when received."*), for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of:

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received,*

for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

Claim 7:

Padwick, in view of Rand, fails to expressly disclose/teach:

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, *Chen teaches "matched message terms that are identified based upon an author profile" and "altering the electronic message when authored."*);

for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include the step of:

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored,*

for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

Claim 8:

Padwick discloses *collecting and storing significant terms in the online registry* (see Chapter 28 – Creating and Using Rule; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” → Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the rules constitute an “*online registry*” of “*significant terms*”).

Claim 9:

Padwick discloses *a user selecting significant terms* (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user “*selects significant terms*”).

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Claim 10:

Padwick discloses *importing significant terms* (see Chapter 28 – Creating and Using Rule; “*Managing Rules*” → Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

Claim 11:

Padwick discloses *significant terms that are imported from an address book* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes an address book).

Claim 12:

Padwick discloses *significant terms that are imported from a database* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes a database).

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Claim 13:

Padwick discloses *significant terms that comprise names of people, product terms or key words in a user's field* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include "*names of people*"; for example, see Figure 28.4).

Claims 14-16:

Padwick, in view of Rand, and further in view of Chen, fails to expressly disclose/teach:

- *making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type.*

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well known by one of ordinary skill in the art at the time the invention was made. Rand expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user.

Changing the font effect, font type, and/or color of text in an electronic document was well known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art – computer programmers – would have known how to design a search tool so a user could select the particular

color, font effect, and/or font type in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types, for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, and further in view of Chen, to include *making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type*, for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 19:

Padwick discloses *identifying where the alterations to the matched message terms*, taught by Rand, *are to be performed according to a **user setting*** (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms; thus, making the search term "distinct" is performed "*according to a user setting*").

Claim 20:

Padwick discloses *significant terms that are categorized and the user setting is based upon a category of the significant term* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way; for example, Outlook can search for all emails that include the term "deadline" and send those emails to a certain folder, or Outlook can search for all emails that include the term "office party" and delete those emails; thus, the significant terms are "categorized" and the user setting processes emails having the significant terms "*based on a category of the significant term*").

Claim 21:

Padwick fails to expressly disclose *displaying the electronic message if the end of the electronic messages as been reached*.

Rand teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1 and 3; see Paragraphs 0015 and 0049 → Rand teaches this limitation in that the electronic document display system includes an "Keyword Search" tool that allows the user to search documents for a particular term or phrase), *comprising the step of:*

- *displaying the electronic message if the end of the electronic messages as been reached* (see Paragraph 0049 → Rand teaches this limitation in that the electronic document display system allows the user to click on any of the documents in the list and, upon selection of a listed document by the user, displays the document with the highlighted search term; thus, the electronic document processing system has scanned the document for the significant term and displays the document “*if the end of the electronic messages as been reached*”),

for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of *displaying the electronic message if the end of the electronic messages as been reached*, for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.

Claim 22:

Padwick fails to expressly disclose *querying a user before making alterations to the electronic message*.

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Rand teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1 and 3; see Paragraphs 0015 and 0049 → Rand teaches this limitation in that the electronic document display system includes an “Keyword Search” tool that allows the user to search documents for a particular term or phrase), *comprising the step of:*

- *querying a user before making alterations to the electronic message* (see Figures 1 and 3; see Paragraphs 0015 and 0049 → Rand teaches this limitation in that the electronic document display system allows the user to search the document for particular terms and distinctly displays those terms; thus, the electronic document processing system “*queries the user before making alterations to the electronic message*”),

for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of *querying a user before making alterations to the electronic message*, for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.

Claims 23, 26-38 and 41-44:

These claims merely recite an apparatus for performing the method of Claims 1, 4-16 and 19-22. Padwick discloses an “*electronic message processor*” (Claim 23, Line 3), Rand teaches an “*electronic message editor*” (Claim 23, Line 6) and Chen teaches a computer apparatus (see Figure 1A).

Thus, Claims 23, 26-38 and 41-44 are rejected using the same rationale used in the above rejections for Claims 1, 4-16 and 19-22, respectively.

Claims 45, 48-60 and 63-66:

These claims merely recite computer software for performing the method of Claims 1, 4-16 and 19-22. Padwick, Rand and Chen operate via computer software.

Thus, Claims 45, 48-60 and 63-66 are rejected using the same rationale used in the above rejections for Claims 1, 4-16 and 19-22, respectively.

Claims 17, 18, 39, 40, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Rand and Chen, and further in view of Abu-Hakima et al., U.S. Patent Application Publication No. US 2003/0020749 A1.

Claim 17:

As indicated in the above rejection, Padwick, in view of Rand and Chen, discloses/teaches every limitation of Claim 1.

Padwick, in view of Rand and Chen, fails to expressly disclose/teach:

- *inserting an object into the electronic message near the matched message term.*

Abu-Hakima teaches a *method for identifying and distinguishing words contained within an electronic message* (see Paragraphs 0001 and 0006-0008 → Abu-Hakima teaches this limitation in that the electronic document processor searches for concepts and displays those concepts), comprising the steps of:

- *inserting an object into the electronic message near the matched message term*

(see Figure 4; see Paragraph 0067 → Abu-Hakima teaches this limitation in that the electronic document processor displays the concept within an icon), for the purpose of calling the user's attention to the message in which the matched significant message term is located.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand and Chen, to include *inserting an object into the electronic message near the matched message term*, for the purpose of calling the user's attention to the message in which the matched significant message term is located, as taught by Abu-Hakima.

Claim 18:

Padwick, in view of Rand and Chen, fails to expressly disclose/teach:

- *an object that comprises an image, a sound file, an icon, a link or a video.*

Abu-Hakima teaches *a method for identifying and distinguishing words contained within an electronic message* (see Paragraphs 0001 and 0006-0008 → Abu-Hakima teaches this limitation in that the electronic document processor searches for concepts and displays those concepts), *comprising the steps of:*

- *selecting an object that comprises an image, a sound file, an icon, a link or a video* (see Figure 4; see Paragraph 0067 → Abu-Hakima teaches this limitation in that the electronic document processor displays the concept within an icon), for the purpose of calling the user's attention to the message in which the matched significant message term is located.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include *selecting an object from the group consisting of an image, a sound file, an icon, a link and a video*, for the purpose of calling the user's attention to the message in which the matched significant message term is located, as taught by Abu-Hakima.

Claims 39 and 40:

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Padwick discloses an "*electronic message processor*" (Claim 23, Line 3), Rand

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teaches an “*electronic message editor*” (Claim 23, Line 6), Chen teaches a computer apparatus and Abu-Hakima teaches “system architectures” (see Paragraph 0001).

Thus, Claims 39 and 40 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Claims 61 and 62:

These claims merely recite computer software for performing the method of Claims 17 and 18. Padwick, Rand, Chen and Abu-Hakima operate via computer software.

Thus, Claims 61 and 62 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Claims 1, 4-16, 19-23, 26-38, 41-45, 48-60 and 63-66 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Chen.

Claim 1:

Padwick discloses a *computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Chapter 28 – Creating and Using Rules, “*Using the Rules Wizard to Manage Incoming Messages*” Pages 1-16 of 16 → Padwick discloses this limitation in that Outlook includes an “Rules

Wizard" tool that allows the user to search emails for a particular term or phrase),
comprising the steps of:

- *creating and reading electronic messages in an electronic messaging application performed by a computer (Padwick discloses this limitation in that Outlook allows the user to create and read emails), wherein the electronic messaging application sends an electronic message from an originator to a recipient via a network (Padwick discloses this limitation in that Outlook sends emails created by the user to a recipient via a computer network), and the electronic messaging application identifies certain words that are contained within the electronic message (as explained in the immediately following discussion, Padwick discloses this limitation) by performing the steps of:*
 - *comparing message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry (see Figure 28.7; see Pages 1-11 of 16 → Padwick discloses this limitation in that the "Rules Wizard" tool allows the user to create rules to filter emails based on whether user-specified terms are in the emails. Every rule created is stored on the computer, so that the rules may be subsequently applied to emails. Thus, the user-specified terms are "stored" by an "online registry."); and*
 - *identifying the matched message terms and indicating their significance to a reader by sending electronic messages that include any matched*

significant message terms to a folder (see Figure 28.8; see Pages 1-11 of 16 → Padwick discloses this limitation in that the "Rules Wizard" tool allows the user to specify that emails satisfying a rule are moved to a particular folder. By moving emails that include user-specified terms to a particular folder, Padwick "*identifies the matched message terms*" and "*indicates their significance to a reader.*").

Padwick fails to expressly disclose:

- *the electronic messaging application **distinguishing** certain words that are contained within the electronic message by performing the step of:*
 - ***making alterations** to the electronic message to identify the matched message terms and to indicate their significance to a reader*
- (EXAMINER'S INTERPRETATION – These two phrases (i.e., "*an application that distinguishes certain words*" and "*making alterations to the electronic message*" essentially recite the same subject matter. That is, these limitations recite: an "*electronic messaging application*" that automatically "*distinguishes*" certain words in a "*message*" by "*making alterations*" to those words for the purpose of indicating the significance of those words to a reader of the "*message.*"), *wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient.*

Chen teaches *a computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising:*

- *an electronic messaging application distinguishing certain words that are contained within the electronic message* (as explained in the immediately following discussion, Chen teaches this limitation) *by performing the step of:*
 - *making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient* (see Figure 1B; see Column 3, Line 37 through Column 4, Line 5; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. When a user-specified keyword is detected in an email, the system designates the email for storage in a user-specified folder. In this way, the system “alters the

email.” Subsequently, when the email is viewed by the user, the system highlights the user-specified keyword. By highlighting the user-specified keywords, Chen *“identifies matched message terms”* and *“indicates their significance to a reader.”* Additionally, the system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches *“altering the electronic message when authored by its originator or received by its recipient.”*),

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *an electronic messaging application distinguishing certain words that are contained within the electronic message by performing the step of:*
 - *making alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader, wherein the alterations are made by the electronic messaging application when the electronic message is authored by its originator or received by its recipient,*

for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

Claim 4:

Padwick discloses *significant terms that are determined based upon a reader profile* (see Chapter 28 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” → Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “*reader*”; these rules comprise the “*reader profile*” that determines the “*significant terms*”).

Padwick fails to expressly disclose *an electronic message that is altered when received*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *altering the electronic message when received* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the

background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches *"altering the electronic message when received."*);
for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of *altering the electronic message when received*, for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

Claim 5:

Padwick discloses *significant terms that are determined based upon a author profile* (Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create rules for processing outgoing emails for the "author"; these rules comprise the *"author profile"* that determines the *"significant terms"*).

Padwick fails to expressly disclose *an electronic message that is altered when authored*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *altering the electronic message when authored* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches *"altering the electronic message when authored."*);

for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of *altering the electronic message when authored*, for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

Claim 6:

Padwick fails to expressly disclose:

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*matched message terms that are identified based upon a reader profile*” and “*altering the electronic message when received.*”),

for the purpose of calling the user's attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *matched message terms that are identified based upon a reader profile, wherein the electronic message is altered when received,*

for the purpose of calling the user's attention to the user-specified keywords, as taught in Chen.

Claim 7:

Padwick fails to expressly disclose/teach:

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored.*

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system identifies user-specified keywords within emails and categorizes the emails into user-specified folders), *comprising the step of:*

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored* (see Figure 1B; see Column 3, Lines 37-59; see Column 6, Lines 13-32; see Column 7, Lines 4-40; see Column 8, Lines 15-28; see Column 8, Lines 50-59; see Column 15, Lines 10-28 → Chen teaches this limitation in that the document management system highlights the user-specified keywords within emails. The system, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. The system allows users to identify keywords for both authored emails and received emails. Thus, Chen teaches “*matched message terms that are identified based upon an author profile*” and “*altering the electronic message when authored.*”);

for the purpose of calling the user’s attention to the user-specified keywords.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick to include the step of:

- *matched message terms that are identified based upon a author profile, wherein the electronic message is altered when authored,*

for the purpose of calling the user’s attention to the user-specified keywords, as taught in Chen.

Claim 8:

Padwick discloses *the step of collecting and storing significant terms in the online registry* (see Chapter 22 – Creating and Using Rules; “*Using the Rules Wizard to Create Rules that Manage Incoming Messages*” Pages 1-19 of 19 and “*Creating Rules for Outgoing Messages*” Pages 1-2 of 2 → Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms. Thus, the rules constitute an “*online registry*” of “*significant terms*.”).

Claim 9:

Padwick discloses a *step of collecting and storing [that] comprises a user selecting significant terms* (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user “*selects significant terms*”).

Claim 10:

Padwick discloses a *step of collecting and storing [that] comprises importing significant terms* (see Chapter 28 – Creating and Using Rule; “*Managing Rules*” → Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

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Claim 11:

Padwick discloses *significant terms [that] are imported from an address book* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes an address book).

Claim 12:

Padwick discloses *significant terms [that] are imported from a database* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes a database).

Claim 13:

Padwick discloses *significant terms [that] comprise names of people, product terms or key words in a user’s field* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include “names of people”; for example, see Figure 28.4).

Claims 14-16:

Padwick, in view of Chen, fails to expressly disclose:

- *making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type.*

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well known by one of ordinary skill in the art at the time the invention was made. Chen expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user. Changing the font effect, font type, and/or color of text in an electronic document was well known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art (e.g., computer programmers) would have known how to design a search tool so a user could select the particular color, font effect, and/or font type in which the located search term was displayed for the purpose of facilitating aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types, for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type,

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for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 19:

Padwick discloses *identifying where the alterations to the matched message terms*, taught by Chen, *[is to be] performed according to a user setting* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms; thus, making the search term “distinct” is performed “according to a user setting”).

Claim 20:

Padwick discloses *significant terms [that] are categorized and the user setting is based upon a category of the significant term* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way. For example, Outlook can search for all emails that include the term “deadline” and send those emails to a certain folder, or Outlook can search for all emails that include the term “office party” and delete those emails. Thus, the significant terms are “categorized” and the user setting processes emails having the significant terms “*based on a category of the significant term.*”).

Claim 21:

Padwick fails to expressly disclose *displaying the electronic message if the end of the electronic messages as been reached.*

Chen teaches a *method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *displaying the electronic message if the end of the electronic messages as been reached* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows the user to click on any document in a list of documents meeting the user-specified criteria and, upon selection of one of the listed documents by the user, displays the document with the highlighted search term, Thus, the system has scanned the document for the significant term and displays the document “*if the end of the electronic messages as been reached.*”),

for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of displaying the electronic message if the end of the electronic messages as been reached* for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

Claim 22:

Padwick fails to expressly disclose *querying a user before making alterations to the electronic message*.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *querying a user before making alterations to the electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 → Chen teaches this limitation in that the computer-based document management system allows the user to search documents for particular terms and distinctly displays those terms

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when one of the documents meeting the user-specified criteria is displayed.

Thus, the system "*queries the user before making alterations to the electronic message.*"),

for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of querying a user before making alterations to the electronic message*, for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

Claims 23, 26-38 and 41-44:

These claims merely recite an apparatus for performing the method of Claims 1, 4-16 and 19-22. Padwick discloses and Chen teaches computer systems.

Thus, Claims 23, 26-38 and 41-44 remain rejected using the same rationale used in the above rejections for Claims 1, 4-16 and 19-22, respectively.

Claims 45, 48-60 and 63-66:

These claims merely recite computer software for performing the method of Claims 1, 4-16 and 19-22. Both Padwick and Chen operate via computer software.

Thus, Claims 45, 48-60 and 63-66 remain rejected using the same rationale used in the above rejections for Claims 1, 4-16 and 19-22, respectively.

Claims 17, 18, 39, 40, 61 and 62 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Chen, and further in view of Larson et al., U.S. Patent No. 5,825,854.

Claim 17:

As indicated in the above discussion, Padwick, in view of Chen, discloses/teaches every limitation of Claim 1.

Padwick, in view of Chen, fails to expressly disclose:

- *inserting an object into the electronic message near the matched message term.*

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *inserting an object into the electronic message near the highlighted message term* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),

for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *inserting an object into the electronic message near the matched message term*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

Claim 18:

Padwick, in view of Chen, fails to expressly disclose:

- *an object that comprises an image, a sound file, an icon, a link or a video.*

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system to

audibly highlight a word that is graphically highlighted in an electronic message),
comprising the steps of:

- *selecting an object that comprises an image, a sound file, an icon, a link or a video* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 → Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),

for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *selecting an object from the group consisting of an image, a sound file, an icon, a link and a video*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

Claims 39 and 40:

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Padwick discloses and both Chen and Larson teach computer systems.

Thus, Claims 39 and 40 remain rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

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Claims 61 and 62:

These claims merely recite computer software for performing the method of Claims 17 and 18. Padwick, Chen and Larson operate via computer software.

Thus, Claims 61 and 62 remain rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Response to Arguments

Applicant's arguments filed 07/19/2006 have been fully considered but they are not persuasive.

Rejections Based on Padwick, Chen and/or Larson:

Applicant argues that Chen fails to teach or suggest making alterations to the electronic message to identify the matched message terms and to indicate their significance, wherein the alterations were made by an electronic messaging application, because Chen is not an "electronic messaging application" since emails must be imported into its document management system. See *Response* – Page 17, fifth full paragraph through Page 18, first partial paragraph.

The examiner disagrees.

Chen teaches a document management system that, while operating in the background, monitors both authored emails and received emails for the user-specified keywords within the emails. When a user-specified keyword is detected in an email, the

system designates the email for storage in a user-specified folder. Subsequently, when the email is viewed by the user, the system highlights the user-specified keyword. In Chen, the email application and the "highlighting keywords" application are components of the larger "document management system." Thus, Chen teaches an "electronic messaging application" that makes alterations to an electronic message.

Essentially, Applicant is arguing that the "highlighting keywords" application in Chen is part of a larger "document management system" and is not limited solely to an email application. In the world of computers and software, reciting in a claim that a software function is performed by an "application" rather than a "system" will not make the claim patentable when the prior art discloses software that performs the software function.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is 571-272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH

June 19, 2007

/Doug Hutton/
Primary Examiner
Art Unit 2176